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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/626,189 | 07/24/2003 | Chia-hung Chen | 5852 | 1546 |

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06/28/2005

David L. Hedden
ASHLAND INC.
P.O. Box 2219
Columbus, OH 43216

EXAMINER

RONESI, VICKEY M

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,189

Applicant(s)

CHEN ET AL.

Examiner

Vickey Ronesi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-5 and 7-10 are now pending in the application.
2. The outstanding objections to the specification and claims and 35 USC 112 rejections are withdrawn in light of applicant's amendment filed 6/13/2005 (pages 5-7).
3. The outstanding 35 USC 102 rejection over Mizutani et al (JP 58-109534) is withdrawn in light of applicant's amendment filed 6/13/2005 (pages 9-10).
4. Applicant's statement of common ownership at the time of the invention of the instant application and US 6,288,139 on page 7 of the amendment filed 6/13/2005 is acknowledged.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
6. The new grounds of rejection set forth are necessitated by applicant's amendment. Thus, the following Office action is properly made final.

Claim Objections

7. Claim 1 is objected to because of a typographical error: the word "is" in line 3 of the claim should be deleted.

Claim Rejections - 35 USC § 112

8. Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 and 10 are dependent on claim 6; however, claim 6 has been cancelled.

Claim Rejections - 35 USC § 102

9. Claims 1-5 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Skoglund (US 6,288,139, cited on IDS dated 7/24/2003).

The rejection is adequately set forth in paragraph 6 of Office action mailed 1/12/2005 and is incorporated here by reference.

Double Patenting

10. Claims 1-5 and 7-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 11-16 of U.S. Patent No. 6,288,139.

The rejection is adequately set forth in paragraph 8 of Office action mailed 1/12/2005 and is incorporated here by reference.

Response to Arguments

11. Applicant's arguments filed 6/13/2005 have been fully considered but they are not persuasive. Specifically, applicant argues that the transitional phrase "consisting essentially of" excludes a polyisocyanate since the inclusion of a polyisocyanate component in the phenolic resole resin composition would materially affect the composition because it is known that the hydroxy groups of the phenolic resole resin will react with the isocyanate groups of the polyisocyanate (pages 7-8 and 9).

While the examiner agrees that the hydroxy groups of the phenolic resole resin will react with the isocyanate groups of the polyisocyanate, nonetheless, applicant's attention is drawn to MPEP 2111.03 which discloses that the transitional phrase "consisting essentially of" limits the

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scope of a claim to the specified materials that do not materially affect the basic and novel characteristics of the claimed invention. Therefore, absent a clear indication of what the basic and novel characteristics are and how and to what extent they are materially affected by the presence of polyisocyanate, “consisting essentially of” is construed as equivalent to “comprising.”

In addition, the fact remains that claim 1 of Skoglund (US ‘139) is open to any amount of isocyanate, including very small amounts. Although one portion of Skoglund discloses that the polyisocyanate used is preferably present from 10 to 500 wt % based on the weight of the phenolic resole resin (col. 3, lines 46-49), the scope of claim 1 encompasses all amounts of polyisocyanate. It is perfectly proper for the examiner to look to the whole reference for what it teaches rather than merely rely on preferred embodiments. *In re Courtright* 153 USPQ 735 (CCPA 1967).

Furthermore, the argument that the polyisocyanate would materially affect the composition is a conclusory statement with no evidentiary weight, i.e., attorney’s statements are not a substitute for factual evidence. Case law holds that “[i]f an applicant contends that additional steps or material in the prior art are excluded by the recitation of ‘consisting essentially of,’ applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention.” *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964).

Applicant is advised to submit clear and convincing evidence in the form of a declaration. Claim 1 of Skoglund (US ‘139) is open to any amount of isocyanate, including very small amounts. It is applicant’s burden to submit data to show that such small amounts of

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polyisocyanate would materially affect the basic and novel characteristics of the claim invention and thus would be excluded from claims that recite "consisting essentially of."

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

06/22/2005

vr

✓

Vasu Jagannathan
VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700